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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,248	05/31/2000	Annegret Janssen	96-082-1-US-01	3770

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EXAMINER

LORENZO, JERRY A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 01/17/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Applicati n No.

09/584,248

Applicant(s)

JANSSEN, ANNEGRET

Examiner

Jerry A. Lorengo

Art Unit

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-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1,6,10,15,16,19,21-23 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,6,10,15,16,19,21-23 and 26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1,6,10,15,16,19,21-23 and 26-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

(1)

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 27-36, drawn to a lamination, classified in class 428, subclass 98.
- II. Claims 1, 6, 10, 15, 16, 19, 21-23 and 26, drawn to a method of coating, classified in class 156, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a non-coating methodology wherein a self-supporting film of hot melt adhesive is interposed between a transparent film and a substrate followed by lamination.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Allison Johnson on December 20, 2001 a provisional election was made without traverse to prosecute the invention of Group II, claims 1, 6, 10, 15, 16, 19, 21-23 and 26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

(2)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, from which claim 16 depends, discloses that the substrate onto which the coating is applied is “a substantially non-porous substrate.” Claim 16, however, discloses that the “substrate is selected from the group consisting of film, foil, paper and combinations thereof.” It is not understood by the examiner how a substrate such as paper, given its absorptive and porous nature, can be considered “a substantially non-porous substrate.”

(3)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

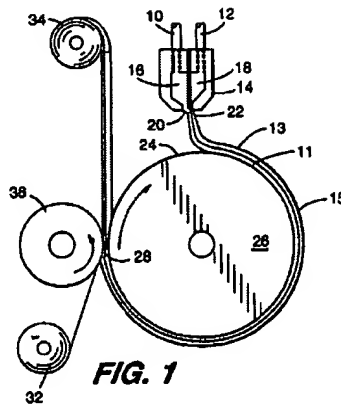
Claims 1, 6, 19, 21 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/15722 to Bayer, Jr. et al.

Regarding applicant claims 1 and 6, Bayer, Jr. et al. disclose a method of coating wherein a hot melt polymeric adhesive coating 11,13, made thermally flowable, is released from a coating device 14 onto a substantially non-porous substrate (application roller) 26 as a substantially continuous coating (film) without contact between the coating device 14 and the surface 24 of the substrate 26 (Figure 1; abstract).

With further regards to applicant claim 6, Bayer, Jr. et al. also disclose that the surface 24 of the substrate (application roller) 26 may have a release coating thereon (page 8, lines 19-22) to facilitate the transfer of the coating from the surface 24 of the substrate 26 to a second substrate

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(paper) 30 (Figure 1; abstract; page 4, lines 13-17; page 9, lines 5-12). The methodology of Bayer, Jr. et al. is illustrated below:



Regarding applicant claim 19, Bayer, Jr. et al. disclose that the coating device 14 is a slot nozzle; and more specifically comprises a manifold die having first and second chambers 16 and 18 each having a single slot-shaped die opening 20 and 22, respectively (page 7, lines 1-25).

Regarding applicant claims 21 and 22, Bayer, Jr. et al. disclose that the hot melt thermoplastic coating 11, 13 exits the slot nozzle at a rate of 1.42 g/s and 0.675 g/s, respectively (page 7, lines 25-27; page 8, lines 1-2), for a total exit rate of 2.095 g/s ($1.42 + 0.675 = 2.095$).

They also disclose that the paper substrate 30 to be transfer coated has a width of 0.305 m (30.5 cm) and is fed at a rate of 1.5 m/s (page 9, lines 5-12), which results in a paper feed rate, in area per unit time, of $0.4575 \text{ m}^2/\text{s}$ ($0.305 \times 1.5 = 0.4575$).

Thus, given a coating feed rate of 2.095 g/s, the area weight of the coating disposed on the paper 30 by transfer from the application roller 26 is 4.579 g/m^2 ($2.095/0.4575 = 4.579$); a value which is less than the 30 and 10 g/m^2 set forth in applicant claims 21 and 22.

(4)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,407,689 to Ohtsuki et al.

Regarding applicant claim 1, Ohtsuki et al. disclose a method of coating wherein a hot melt polymeric adhesive coating, made thermally flowable, is released from a coating device 7 simultaneously onto substantially non-porous substrates 1 and 4 as a substantially continuous coating (film) without contact between the coating device 7 and the surface of the substrates 1 and 4 (Figure 1; abstract; column 5, lines 31-42).

Regarding applicant claim 16, Ohtsuki et al. disclose that the first substrate 1 can comprise a foil while the second substrate 2 can comprise thermoplastic resin film (column 5, lines 31-42).

(5)

Claims 10, 15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/25902 to Werenicz et al.

Regarding applicant claim 10, Werenicz et al. disclose a method of coating wherein a hot melt polymeric adhesive coating, made thermally flowable, is released from a coating device 3 onto a substrate 1 as a substantially continuous coating (film) without contact between the coating device 3 and the surface of the substrate 1, wherein the coating has a complex viscosity of less than about 500 poise at about 1000 radians/sec at the coating temperature (Figure 1; abstract; page 4, lines 16-18).

Regarding applicant claim 15, Werenicz et al. further disclose that the coating has a complex viscosity of between about 100 and about 1000 poise at 1 radian/second (page 4, lines 19-20).

Regarding applicant claim 23, Werenicz et al. disclose that the thermoplastic composition is coated, i.e., is released from the coating device 3, at a temperature of less than 125°C (page 4, lines 11-14).

(6)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/15722 to Bayer, Jr. et al., as set forth in section (3), above, in view of WO 96/25902 to Werenicz et al.

Bayer, Jr. et al., as set forth in section (3), above, discloses a coating method wherein a hot melt polymeric adhesive coating, made thermally flowable, is released from a coating device onto a substantially non-porous substrate as a substantially continuous coating (film) without contact between the coating device and the surface of the substrate. Although Bayer, Jr. et al. disclose that the slot die is spaced from the substrate, they do not disclose, as per applicant claim 26, the specific distance between the coating device and the substrate.

Werenicz et al., however, also drawn to the non-contact slot-coating of hot melt adhesives onto a substrate, disclose that it is known to vary the spacing of the slot die from the substrate by a distance from about 0.5 mm to about 20 mm. They also disclose that it is possible to increase the distance to greater than 20 mm with suitable machine settings, and with specific adhesives or other coating materials (page 6, lines 11-15).

It would have therefore been obvious to one of ordinary skill in the art at the time of invention to modify the slot die and substrate spacing in the method of Bayer, Jr. et al., as suggested by Werenicz et al., motivated by the fact that both Werenicz et al. and Bayer, Jr. et al. are drawn to the same basic methodology and apparatus and furthermore by the fact that they both disclose that it is known in the art to optimize the coating process and apparatus for the materials to be extruded through the slot die (page 7, lines 3-12).

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(7)

Note to Applicant

The references cited in PCT/EP98/01588 have been fully considered. Both the Bayer, Jr. et al. and Ohtsuki et al. references have been utilized in forming the grounds of rejection set forth above both alone and in combination with prior art revealed during an extensive search of the relevant prior art.

(8)

Priority

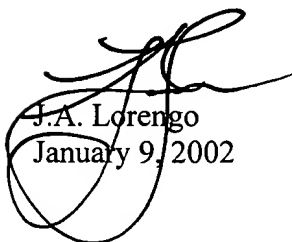
Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 12/01/1997. It is noted, however, that applicant has not filed a certified copy of the 19753266.7 application as required by 35 U.S.C. 119(b).

(9)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J.A. Lorengo
January 9, 2002